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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,516	05/31/2000	David A. Grabelsky	00,011	1984
7590 03/01/2004			EXAMINER	
McDONNELL BOEHNEN HULBERT & BERGHOFF			HOM, SHICK C	
300 South Wacker Drive			ART UNIT	
Chicago, IL 60606			PAPER NUMBER	
			2666	

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/584,516

**Applicant(s)**

GRABELSKY ET AL.

**Examiner**

Shick C Hom

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,9 and 11-14, 16, 19, 23, 27 is/are rejected.
- 7) ☒ Claim(s) 6-8,10,15,17,18,20-22,24,26 and 28-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3, 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The disclosure is objected to because of the following informalities: in page 1 lines 5-6 update status of U.S. Application No. 09/035,600 as now being U.S. Patent no. 6,353,614. In page 31 line 19 update status of U.S. Application No. 09/270,967 if known. In page 3 lines 8-10 which recite P. Srisureh, "IP Network Address Translator (NAT) Terminology and Considerations," Aug. 1999 and in page 28 lines 12-13 which recite Cuervo et al., "Megaco Protocol" being incorporated by reference is objected to because a copy of the references must be provided for proper consideration. Appropriate correction is required.

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***Claim Objections***

3. Claims 14-33 are objected to because of the following informalities: in claim 14 line 3 delete typo "clienton" and insert ---client on---. In claims 30 and 32 line 2 spell-out acronym MEGACO, i.e. delete ---MEGACO--- and insert ---Media Gateway Control MEGACO---, for clarity. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. Claims 5 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It appears that claims 12 and 5 are the same and therefore is not clear as to what further limitation is recited in claim 12 that is not already claimed in claim 5.

5. Claims 14, 16, and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,353,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claim 14 merely broaden the

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scope of U.S. Patent No. 6,353,614 claims 4 and 9 by eliminating the method being of distributed network address translation. Application's dependent claim 16 corresponds to U.S. Patent No. 6,353,614 claim 11; and application's dependent claim 25 corresponds to U.S. Patent No. 6,353,614 claim 9. It has been held that the omission of a element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal

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disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-5, 9, 11-14, 16, 19, 23, 25, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Andrews et al. (5,835,723).

Regarding claim 1:

Andrews et al. disclose the method of implementing Realm Specific Internet Protocol in a network access system comprising a plurality of network sub-devices connected by a network, the method comprising the steps of: (a) requesting by a first network sub-device using a first protocol a common external network address and one or more ports from a second network sub-device to identify a first network sub-device during communications with an external

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computer network (see col. 3 lines 4-19 and col. 4 lines 18-25); (b) receiving the common external network address and an identifier of the one or more ports at the first network sub-device from the second network sub-device (see abstract and col. 1 line 64 to col. 2 line 29); (c) updating entries in an address-to-address table maintained by the second network device to reflect assignment of the common external network address and one or more ports to the first network sub-device (see col. 6 lines 45-52); and (d) creating a combination network address for the first network sub-device with the identifier of the one or more ports and the common external network address, the combination network address identifying the first network sub-device for communications with the external computer network (see col. 3 lines 4-19, col. 4 lines 18-25, and col. 8 lines 7-27).

Regarding claim 2:

Andrews et al. disclose the computer readable medium having stored therein instructions for causing a central processing unit to execute the method of claim 1 (see col. 1 line 64 to col. 2 line 29).

Regarding claim 3:

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Andrews et al. disclose the method of claim 1 further comprising (a) sending a request from the first network sub-device to the second network sub-device; (b) routing the request from the second network subdevice to the external computer network (see col. 3 lines 4-19 and col. 4 lines 18-25); (c) receiving a reply at the second network subdevice on the common external network address for the network access system (col. 1 lines 64 to col. 2 line 29); and (d) routing the reply from the second network subdevice to the first network subdevice using the locally unique port from the combination network address (see col. 3 lines 4-19).

Regarding claim 4:

Andrews et al. disclose wherein the first protocol is a Realm Specific Internet Protocol comprising a Realm Specific Internet Protocol assign request message, a Realm Specific Internet Protocol assign response message, and a combination network address involving a locally unique port and a common external network address (see col. 3 lines 4-19, col. 4 lines 18-25 and col. 8 lines 7-27).

Regarding claims 5 and 12:



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Andrews et al. disclose wherein the common external network address is an Internet protocol address (see col. 1 lines 41-53).

Regarding claim 9:

Andrews et al. disclose wherein the second network subdevice is a router or a port server (see col. 5 lines 41-55).

Regarding claim 11:

Andrews et al. disclose wherein the external computer network is any of the Internet, an intranet or a public-switched telephone network (col. 1 lines 41-53).

Regarding claim 13:

Andrews et al. disclose wherein the plurality of subdevices on the network access system comprise a local area network and the external network is any of the Internet or an intranet (col. 6 lines 24-44).

Regarding claim 14:

Andrews et al. disclose the network access device, comprising in combination: (a) a first network; (b) a first network subdevice comprising a network client on the first network (see col. 5 lines 41-55), wherein the first network subdevice has a first network address for communicating with other network subdevices and requests from a second

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network subdevice allocation of a second network address and one or more ports for communicating with a plurality of network devices on a second network (see col. 3 lines 4-19 and col. 4 lines 18-25); and (c) a second network subdevice on the first network comprising a network address server for allocating a second network address and one or more ports to the first network subdevice, wherein the second network subdevice has a first network address for communicating with other network subdevices on the first network and a second network address for communicating with a plurality of network devices on a second network, and wherein the network address server is used to allocate the second network address to the first network subdevice on the first network (see col. 3 lines 4-19, col. 4 lines 18-25, col. 8 lines 7-27, and col. 5 lines 41-55).

Regarding claim 16:

Andrews et al. disclose wherein the second network is a public network (in col. 1 lines 41-53 the Internet corresponds to the public network).

Regarding claim 19:

Andrews et al. disclose wherein the first network subdevice further comprises an IP interface and the client of the first network subdevice is a Realm Specific Internet

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Protocol host (see col. 1 lines 41-53 and col. 5 lines 41-55).

Regarding claim 23:

Andrews et al. disclose wherein the first network subdevice further comprises a data application and a device control application (see col. 4 lines 8-25).

Regarding claim 25:

Andrews et al. disclose wherein the second network subdevice is a router subsystem (see col. 5 lines 41-55).

Regarding claim 27:

Andrews et al. disclose wherein the second network is any of the Internet or an intranet (col. 1 lines 41-53).

#### ***Allowable Subject Matter***

9. Claims 6-8, 10, 15, 17-18, 20-22, 24, 26, and 28-33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Borella et al. (6,353,891) disclose control channel security for Realm specific Internet protocol.

Lin et al. (6,282,575) disclose a routing mechanism for networks with separate upstream and downstream traffic.

11. Any response to this nonfinal action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600  
only)

Hand-delivered responses should be brought to  
Crystal Park II, 2121 Crystal Drive, Arlington.  
VA., Sixth Floor (2600 Receptionist at (703)  
305-4750).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick Hom whose telephone number is (703) 305-4742. The examiner's regular work schedule is Monday to Friday from

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8:00 am to 5:30 pm EST and out of office on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao, can be reached at (703) 308-5463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



**DAUGHTON**  
**PRIMARY EXAMINER**

SH

February 24, 2004